

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Norbert Hahn	Art Unit :	3721
Serial No. :	10/688,261	Examiner :	Weeks, Gloria A.
Filed :	October 17, 2003	Confirmation No.:	4594
Title :	TOOL HOLDER FOR IMPACTING MACHINE		

**Mail Stop Appeal Brief – Patents**

Commissioner for Patents

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**APPEAL BRIEF**

This is an Appeal Brief follows;

the Decision to Proceed to Board of Patent Appeals and Interferences in the Notice of Panel Decision from Pre-Appeal Brief Review of October 21, 2010 which followed;

Applicants second Request for Pre-Appeal Brief Conference Review of September 8, 2010, which followed;

the Examiner's non-final Office Action of June 10, 2010, which followed;

a Decision to Reopen Prosecution in the first Notice of Panel Decision from Pre-Appeal Brief Review of March 25, 2010, which followed;

Applicant's first Request for Pre-Appeal Brief Conference Review of February 23, 2010, which followed;

the Examiner's Final Office Action of November 24, 2009.

**TABLE OF CONTENTS**

I.	Real Party in Interest .....	3
II.	Related Appeals and Interferences.....	3
III.	Status of Claims.....	3
IV.	Status of Amendments.....	3
V.	Summary of Claimed Subject Matter.....	3
VI.	Grounds of Rejection to be Reviewed on Appeal.....	5
VII.	Argument.....	5
	A. Introduction.....	5
	B. <i>Huggins</i> and ( <i>Han</i> main body is 16 or 12).....	6
	C. <i>Han</i> main body is 16.....	6
	D. <i>Han</i> Main Body is 12.....	7
	E. Conclusion.....	7
VIII.	Claims Appendix.....	8
IX.	Evidence Appendix.....	13
X.	Related Proceedings Appendix.....	13
XI.	Conclusion.....	13

### **I. Real Party in Interest**

Black & Decker Inc., being the assignee of the present application, is the real party in interest.

### **II. Related Appeals and Interferences**

To the best of the knowledge of Appellants, Appellants' undersigned representative, and the assignee of the present application, no other related appeals, interferences, or judicial proceedings are pending which may be related to, directly affect, or be directly affected by or have a bearing on the Board's decision in the present pending appeal.

### **III. Status of Claims**

Claims 2, 8, 11, and 26-32 have been cancelled. Claims 1, 3-7, 9, 10, 12-19, and 33 are rejected under 35 U.S.C. §102(b), as being anticipated over U.S. Patent No. 5,820,136 to Han et al. ("*Han*"). In addition, claims 1, 20-25 and 33 are rejected under 35 U.S.C. §102(b), as being anticipated over U.S. Patent No. 5,921,563 to Huggins et al. ("*Huggins*"). Applicant believes that the applied reference should correctly be *Huggins* et al. and not Holt as recited in the Office Action. The aforementioned rejections of claims 1, 3-7, 9, 10, 12-25 and 33 are being appealed.

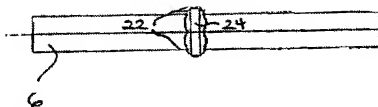
A copy of the claims is provided in the Claims Appendix, below.

### **IV. Status of Amendments**

No Amendments have been made to the claims after Applicant's July 27, 2009 Response to the non-final Office Action of April 28, 2009.

### **V. Summary of Claimed Subject Matter**

The following is a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, with references to the specification and drawings.



claimed tool (6)  
extracted from Fig. 2

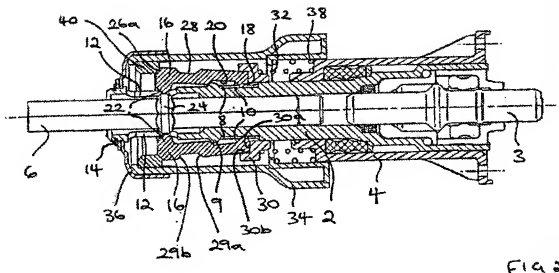


Fig. 2

Independent claim 1 recites a tool holder for a hand supported impacting machine, which tool holder is suitable for receiving a tool (6; Fig.2; par. [0030], ln. 4) having a shank portion on which is formed a retaining collar (24; Fig.2; par. [0033], ln. 7), the tool holder comprising:

a tubular main body (2; Fig.2; par. [0030], ln. 2) for receiving the tool, the tubular main body (2; Fig.2; par. [0030], ln. 2) defining a forward direction extending toward a forward end (leftmost end of the holder) where the tool (6; Fig.2; par. [0030], ln. 4) is inserted into or removed from the main body (2; Fig.2; par. [0030], ln. 2); and

an elongated locking element (16; Fig.2; par. [0032], ln. 1) pivotably mounted at a pivot point (18; Fig.2; par. [0037], ln. 12) on an exterior surface of the main body (2; Fig.2; par. [0030], ln. 2), the locking element (16; Fig.2; par. [0032], ln. 1) including a forward portion including an engaging portion (22; Fig.2; par. [0033], ln. 7) located forward of the pivot point (18; Fig.2; par. [0037], ln. 12) between the pivot point (18; Fig.2; par. [0037], ln. 12) and the forward end of the main body (2; Fig.2; par. [0030], ln. 2), the engaging portion (22; Fig.2; par. [0033], ln. 7) pivotably moveable between a radially inner locked position (see Fig. 1), in which the engaging portion (22; Fig.2; par. [0033], ln. 7) is engageable with the retaining collar of the tool (6; Fig.2; par. [0030], ln. 4), and a radially outer unlocked position (see Figs. 2a, 2b), which

enables a tool (6; Fig.2; par. [0030], ln. 4) to be inserted into or removed from the main body (2; Fig.2; par. [0030], ln. 2); and

a manually actuatable sleeve (34; Fig.2; par. [0034], ln. 3) which is mounted around the main body (2; Fig.2; par. [0030], ln. 2) so as to be moveable between a first position (see Fig. 1) in which the engaging portion (22; Fig.2; par. [0033], ln. 7) of the locking element (16; Fig.2; par. [0032], ln. 1) is held in the locked position and a second position (see Fig. 2a) in which the engaging portion (22; Fig.2; par. [0033], ln. 7) of the locking element (16; Fig.2; par. [0032], ln. 1) is moveable to the unlocked position; wherein the manually actuatable sleeve (34; Fig.2; par. [0034], ln. 3) is axially slideably mounted along the main body (2; Fig.2; par. [0030], ln. 2).

## **VI. Grounds of Rejection to be Reviewed on Appeal**

Appellants present the following issues for review:

Whether the Examiner erred in rejecting claims 1, 3-7, 9, 10, 12-19, and 33 under 35 U.S.C. §102(b), as being anticipated by U.S. Patent No. 5,820,136 to *Han* and whether the Examiner erred in rejecting claims 1, 20-25 and 33 under 35 U.S.C. §102(b), as being anticipated by U.S. Patent No. 5,921,563 to *Huggins*.

## **VII. Arguments**

### **A. Introduction**

Briefly, the present invention is a tool holder that is disposed at a front of a power tool to secure a tool (6) therein for repeated impacts. The tool (6) includes a collar (24). The tool holder has main body (2) that defines a receptacle into which an insertion end of tool (6) is inserted into main body (2) shown in Fig. 1. A pivotable locking element (16) includes an engagement portion (22). Locking element (16) pivots between a first position in which engagement portion (22) engages collar (24) of tool (6) and prevents collar (24), and thus tool (6), from being removed (see Fig. 1) and a second position in which engagement portion (22) is moveable to allow collar (24), and thus tool (6), to be removed from main body (2) (see Fig. 2b).

The Office Action refers to *Han's* main body in one place (pg. 2; 6 lns. from bottom) as 16 and in another (pg. 3; 10 from bottom) as 12. Headings below are labeled accordingly.

**B. Huggins and (Han main body is 16 or 12).**

The following arguments apply to *Huggins* and to *Han* regardless of whether *Han*'s main body is interpreted as 16 or 12.

Specifically, claims 1 and 33 require that the engaging portion 22 be “pivotably movable between” two positions. One position is “a radially inner locked position, in which the engaging portion is engaged with the retaining collar of the tool”. While tool (6) and retaining collar (24) are not positively claimed, only a rejection based on a reference that can be reasonably said to be capable of performing the claimed feature is proper. In this case, neither the *Han* engaging portions (70) nor the *Huggins* engagement portions (40) can be reasonably said to be capable of engaging with an engagement collar of a tool. Both of the *Han* and *Huggins* designs isolate their engaging portions (70, 40) from the receptacle space where their tools (28, 26) engage their holders. In, other words, in both cases, collets (16, 26) separate the engaging portions (70, 40), from the tool receptacle which insures that engaging portions (70, 40) which cannot penetrate the collets will never engage a collar of the tool as required by claim 1. This will be the case regardless of the structure of the tool and collar.

Furthermore, even for argument sake, if collets (16, 26), which are capable of engaging the collar of a tool, were interpreted to be the elongated locking elements 18, 32, the result would be an unreasonable interpretation. This is because in both *Han*'s and *Huggins*'s, collets 16, 26 each have pivot points on an interior surface of main bodies 12, 18. In contrast, claim 1 requires the locking element 16 to have a pivot point 18 on an exterior surface of main body 2.

**C. Han main body is 16.**

Specifically, if *Han*'s main body is 16, the following arguments apply. The June 6, 2010 Office Action recites, “the engaging portions 70 pivotably moveable between a radially inner locked position (figure 4) within a recess 72 of the main body 16, and a radially outer unlock position (figure 2) which enables a tool to be inserted into or removed from the main body” (end of page 2). While a proper rejection requires a complete description of how each claim element is met in the reference, the Office Action, does not appear to explain how *Han* teaches “a radially inner locked position, in which the engaging portion is engaged with the retaining collar of the tool”. This is because *Han*'s engaging portion 70 is incapable of reaching the tool receptacle where *Han*'s tool (28) would be engaged by an engaging member. The only member of *Han* that

is capable of engaging a collar of a tool, regardless of the structure of the tool, is collet 16. However, in this interpretation, collet 16 is already considered by the Examiner to be the main body which, based on the claim language, is not the element that engages the collar of the tool.

**D. Han Main Body is 12.**

Furthermore, if *Han*'s main body is 12, *Han* fails to teach "an engagement portion located forward of the pivot point between the pivot point and the forward end of the main body" as required in the claims. In other words, if the main body is 12, the main body does not extend forward of engagement portion 72 as required by claim 1.

**E. Conclusion**

In view of the foregoing, Applicant respectfully requests the Examiner to find the application to be in condition for allowance with claims 1, 3-7, 9, 10, 12-25, and 33. However, if for any reason the Examiner feels that the application is not now in condition for allowance, the Examiner is respectfully requested to call the undersigned attorney to discuss any unresolved issues and to expedite the disposition of the application.

### **VIII. Claims Appendix**

1. (Previously Presented). A tool holder for a hand supported impacting machine, which tool holder is suitable for receiving a tool having a shank portion on which is formed a retaining collar, the tool holder comprising:

a tubular main body for receiving the tool, the tubular main body defining a forward direction extending toward a forward end where the tool is inserted into or removed from the main body; and

an elongated locking element pivotably mounted at a pivot point on an exterior surface of the main body, the locking element including a forward portion including an engaging portion located forward of the pivot point between the pivot point and the forward end of the main body, the engaging portion pivotably moveable between a radially inner locked position, in which the engaging portion is engageable with the retaining collar of the tool, and a radially outer unlocked position, which enables a tool to be inserted into or removed from the main body; and

a manually actuatable sleeve which is mounted around the main body so as to be moveable between a first position in which the engaging portion of the locking element is held in the locked position and a second position in which the engaging portion of the locking element is moveable to the unlocked position; wherein the manually actuatable sleeve is axially slideably mounted along the main body.

2. (Cancelled). A tool holder according to claim 1 wherein the manually actuatable sleeve is axially slideably mounted along the main body.

3. (Original). A tool holder according to claim 1 and further comprising:  
a retaining ring axially slideably mounted with respect to the main body; and  
a spring member that axially biases the retaining ring into engagement with the locking element so as to bias the locking element engaging portion into the locked position.

4. (Original). A tool holder according to claim 1 and further comprising a spring member that biases the manually actuatable sleeve into the first position.



5. (Original). A tool holder according to claim 1 and further comprising a second locking element.
6. (Previously Presented). A tool holder according to claim 3 wherein the retaining ring is located rearwardly of the locking element and the spring member axially biases the retaining ring in the forward direction.
7. (Original). A tool holder according to claim 3 wherein the axial movement of the retaining ring is independent of the movement of the manually actuatable sleeve.
8. (Cancelled).
9. (Previously Presented). A tool holder according to claim 1 wherein the main body defines a recess and the locking element includes a rearward portion bearing a radially inwardly projecting portion engageable with the recess on the main body so as to facilitate pivoting of the locking element.
10. (Previously Presented). A tool holder according to claim 1 wherein the main body includes a radially outward projection and the locking element includes a radially inwardly facing recess, and the locking element recess is engageable with the projection on the main body so as to facilitate pivoting of the locking element.
11. (Cancelled).
12. (Previously Presented). A tool holder according to claim 1 wherein the locking element includes a radially outward portion and the manually actuatable sleeve includes a radially inward locking member and when the manually actuatable sleeve is in the first position then the locking member is engageable with the radially outward portion of the locking element to hold the engaging portion of the locking element in the locked position.

13. (Original). A tool holder according to claim 12 wherein the locking element includes a reduced external diameter portion and when the manually actuatable sleeve is in the second position then the locking member is located radially outward of the reduced external diameter portion of the locking element.

14. (Original). A tool holder according to claim 12 wherein when the manually actuatable sleeve is in the second position, then the locking member is located one of axially forward and axially rearward of the locking element.

15. (Original). tool holder according to claim 3 wherein the locking element includes a first end and is pivotally mounted on the main body about the first end so that the engaging portion is radially movable with respect to the main body between the locked position and the unlocked position, and the retaining ring defines a recess, and the first end of the locking element is receiveable in the recess so as to guide the pivoting of the locking element

16. (Original). A tool holder according to claim 5 wherein the locking element and the second locking element are pivotally mounted on the main body and, when the engaging portions are in the locked position, the locking element and second locking element together form a sleeve which surrounds the tool inserted within the main body.

17. (Previously Presented). A tool holder according to claim 1 wherein a forward end of the locking element extends forwardly of [a] the forward end of the main body.

18. (Original). A tool holder according to claim 17 wherein the locking element includes a rearward portion and a forward portion, the rearward portion is pivotally mounted on the main body and the engaging portion is located on the forward portion.

19. (Original). A tool holder according to claim 16 wherein the locking element and second locking element both include a resilient ring portion mounted at a ` end of each locking element,

and in the locked position of the engaging portions of the locking elements the ring portions together form a resilient nose ring.

20. (Previously Presented). A tool holder according to claim 1 wherein the main body defines a radial through hole, and the locking element has a radially inwardly extending engaging portion extendable through the through hole.

21. (Original). A tool holder according to claim 20 wherein the through hole is axially longer than the engaging portion of the locking element.

22. (Original). A tool holder according to claim 20 and further comprising:

- a retaining ring axially slideably mounted around the main body rearward of the locking element;

- a spring member for forwardly biasing the retaining ring into engagement with the locking element; and

- wherein the locking element is axially slideably mounted on the main body.

23. (Original). A tool holder according to claim 22 wherein the manually actuatable sleeve member includes a locking member located within the manually actuatable sleeve and in the locked position of the sleeve the locking member engages a radially outward portion of the locking element to hold the engaging portion of the locking element in the locked position, and wherein the retaining collar of a tool inserted into the main body is engageable with the locking element so as to push the locking element to a rearward position against the force exerted by the forward biased retaining ring.

24. (Previously Presented). A tool holder according to claim 23 wherein the rearward position of the locking element is rearward of the locking member, and in the rearward position of the locking element the engaging portion of the locking element is moveable to the unlocked position.

25. (Original). A tool holder according to claim 22 wherein the main body includes an outer surface and the outer surface defines a recess and a slot extending axially rearwardly from the recess, and wherein the locking element is axially slideably guided in the slot and pivotable in the recess.

26 - 32. (Cancelled).

33. (Previously Presented). A hand supported impacting machine comprising a hammering mechanism and a tool, the tool holder is suitable for receiving a tool having a shank portion including a retaining collar, and wherein the tool holder comprises:

a tubular main body for receiving the tool, the tubular main body defining a forward direction extending toward a forward end where the tool is inserted into or removed from the main body;

an elongated locking element pivotably mounted at a pivot point on an exterior surface of the main body, the locking element including a forward portion including an engaging portion located forward of the pivot point between the pivot point and the forward end of the main body, the engaging portion pivotably moveable between a radially inner locked position, in which the engaging portion is engageable with the retaining collar of the tool, and a radially outer unlocked position, which enables a tool to be inserted into or removed from the main body; and

a manually actuatable sleeve which is mounted around the main body so as to be moveable between a first position, in which the engaging portion of the locking element is held in the locked position, and a second position, in which the engaging portion of the locking element is moveable to the unlocked position; wherein the manually actuatable sleeve is axially slideably mounted along the main body.

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Serial No. : 10/688,261  
Filed : October 17, 2003  
Page : 13 of 13

Attorney Docket No. P-US-PR-1088

**IX. Evidence Appendix**

None.

**X. Related Proceedings Appendix**

None.

**XI. Conclusion**

Enclosed is authorization to charge \$540.00 for the Appeal Brief fee to deposit account 02-2548 .

Respectfully submitted,

Date: December 20, 2010

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